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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,772	03/22/2004	Michael L. Creekmore	006429.00004	1232
7303	7590	02/08/2005	EXAMINER	
FRANK J CATALANO FRANK J CATALANO, P.C. 100 WEST 5TH ST., 10TH FLOOR TULSA, OK 74103-4990			COURSON, TANIA C	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/805,772

Applicant(s)

CREEKMORE, MICHAEL L.

Examiner

Tania C. Courson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12,13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12,13 and 15-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 12-13, 15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Bahar et al. (US 6,203,168 B1).

Bahar et al. discloses in Figures 1 and 3, an illuminating box comprising:

With respect to Claims 12-13 and 15:

- a) a substantially flat elongated member (Fig. 1, illuminating box 10) having a straight edge (Fig. 3, bottom edge 21), said edge having a lengthwise cavity therein (Fig. 3, interior chamber 19), an encased light source and a plurality of passages extending within said member from said light source (Fig. 3, three light bulbs 28);
- b) said member having a chamber therein encapsulating said light source (Fig. 3, interior chamber 19), and;
- c) said member being a straight edge (Fig. 1, illuminating box 10).

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With respect to Claim 17:

- a) a substantially flat elongated member (Fig. 1, illuminating box 10) having a straight edge (Fig. 3, bottom edge 21);
- b) said edge having a lengthwise cavity therein (Fig. 3, interior chamber 19);
- c) at least one light source within said member dispersing light into said cavity (Fig. 3, sources of light 20);
- d) said cavity directing the light at the workpiece (Fig. 3).

With respect to the preamble of the claims 1 and 17: the preamble of the claim has not been given any patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self – contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 ( CCPA 1951).

With respect to claims 1 and 17: With respect to the intended use of the apparatus, e.g. for abutment with the workpiece to be tested, for conducting light emitted from said source: It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

It has been held that the functional “whereby” statement does not define any structure and accordingly can not serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

With respect to claim 15, the straight edge disclosed by Bahar et al. is considered to be in a broad sense, a “machinist’s” straight edge since Bahar et al. clearly shows the box having a linear edge (Fig. 3, bottom edge 21). Furthermore, the term “machinist’s” does not add any structural limitation to the term “straight edge”, thus it does not provide enough patentable weight.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar et al., as applied to claims 12-13, 15 and 17 as stated above, and further in view of Queen (US 2,745,183)

Bahar et al. disclose an illuminating box as stated above in paragraph 2.

They do not disclose a member being a square.

Queen teaches a toolmaker’s square that contains a member being a square (Fig. 1, blade 11). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the an illuminating box of Bahar et al. so as to include a member being a square, as taught by Queen, in order to afford a direct reading of the deviation of

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the work from a right angle or other given predetermined angle (column 1, lines 17-18) during use of the tool.

With respect to claim 16, the square disclosed by Queen is considered to be in a broad sense, a “machinist’s” square since Queen clearly shows a toolmaker’s square (Fig. 1). Furthermore, the term “machinist’s” does not add any structural limitation to the term “square”, thus it does not provide enough patentable weight.

#### ***Response to Arguments***

5. Applicant's arguments filed on November 15, 2004, have been fully considered but they are not persuasive.

6. In response to applicant's argument that the references fail to show certain features of applicant's invention, based on the definition of “straight edge”. Clarification of this definition is as follows, the definition for “straightedge” (note this is one word) is as the applicant defines from *Webster's Encyclopedia Unabridged Diction of the English language, 1989 edition*, “a bar or strip of wood or metal...for use in drawing or testing straight lines, planes, etc.”. The applicant's claims and specification support the words “straight edge”, note this is a combination of two separate words, thus the definition of the one word “straightedge” does not apply. Even if the applicant were to change the claim language and the specification to state the one word “straightedge”, the references and current rejection would still apply.

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7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., locating flaws in a single planar surface) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania C. Courson whose telephone number is (571) 272-2239. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (571) 272-2245.

The fax number for this Organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DIEGO F.F. GUTIERREZ  
SUPERVISORY PATENT EXAMINER  
GROUP ART UNIT 2859

TCC  
February 7, 2005

**CHRISTOPHER W. FULTON**  
**PRIMARY EXAMINER**